

## **REMARKS**

Applicant has reviewed the Office Action mailed November 19, 2003. Claim 32 is being added by this Response. Thus, claims 1 through 32 are pending in the application. Support for the newly added claim 32 may be found throughout the Specification. Specifically, support for the claim 32 may be found in FIG. 6, item 604, and in the Specification at Page 8, Lines 11-16. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

### ***Traversal of Inherency***

The Office Action maintains the Examiner's contention that a processor is inherently included in the receiving and retaining elements in the Crowell patent. Applicant respectfully disagrees with these contentions. To establish inherency, MPEP §2112 requires that the allegedly inherent feature must necessarily be present, and not merely a possibility:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP §2112 citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' MPEP §2112 quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

In the present context, it is certainly foreseeable that the function of the receiving and retaining elements in the Crowell patent may not be configured with a processor in the manner recited in the claims. Such receiving and retaining can be accomplished without the use of a processor. For example, receiving and retaining can be achieved using, magnetic analog technology.

Consequently, it is respectfully submitted that the processor feature is not inherent as described in the Crowell documents. Accordingly withdrawal of the allegation of inherency is earnestly requested.

***Claim Rejection – 35 U.S.C. §103***

The Office Action includes multiple 35 U.S.C. §103(a) rejections: i) Claims 1, 4, 16, 22, 23, 28, and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of US Patent No. 5,815,586 (“Dobbins”); ii) Claims 1, 3, 6-14, 16, 18-21, and 23-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent No. 5,577, 918 (“Crowell”); iii) Claims 2, and 29-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Crowell in view of US Patent No. 4,611,262 (“Galloway”); and iv) Claims 5, 15, and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Crowell in view of US Patent No. 5, 853,372 (“Britton”). Applicant respectfully traverses these rejections and requests their withdrawal for the following reasons.

The six independent Claims 1, 9, 10, 16, 23, and the newly added independent claim 32, of the instant application recite features that are not taught or suggested by the prior art. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143, *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Claim 1 and 32, of the present invention, recite the use of audio file instructions for setting up a computer system. In contrast, the Dobbins patent involves the use of audio instructions only for medication containers and not for setting up a computer system. The Crowell patent, as discussed above, does not inherently teach a processor and memory as recited in Claims 1 and 32. The Galloway patent is cited merely for its mention of using a piezoelectric transducer in a greeting card while the Britton patent is cited for its discussion of using photo diodes in conjunction with medical equipment. Neither the Galloway nor Britton patents overcome the deficiencies of the Crowell patent.

A container capable of holding computer system components having audio setup instructions attached, is recited in claim 9. An audio assisted setup apparatus affixed to a

component of the computer, is recited in claim 10. The features of these claims are not disclosed, taught, or suggested in any of the cited references.

Claim 16, of the present invention, recites a method of assisting a user in set up of a computer system. Nowhere, in either the Dobbins or Crowell patents, is it disclosed, taught, or suggested that the method of the present invention is a preferred embodiment or even a relevant consideration. When discerning the teachings of a patent it is often crucial to reveal what is not being stated by the reference. In this case the non-existence of any mention of a method, similar to the method of the present invention, reveals that the present invention is indeed unique and is not read on by the prior art.

Claim 23, of the present invention, recites providing a user a set of audio instructions for setting up a computer system. Nowhere in either the Dobbins or Crowell patents is it disclosed, taught, or suggested that the invention of the Dobbins or Crowell patents may be used in conjunction with a computer system or set up of a computer system. Indeed, the Dobbins device is limited to instructions for taking medication provided in medication containers and the Crowell patent makes no mention of a computer whatsoever.

### ***§103 Rejection of the Claims in View of Dobbins***

The §103 rejection of claims 1, 4, 16, 22, 23, 28, and 31 in view of Dobbins is respectfully traversed. The Office Action contends that all features of claims 1, 4, 16, 22, 23, 28, and 31 are disclosed in the Dobbins patent. Applicant respectfully disagrees.

The three Independent Claims 1, 16, and 23 of the instant application recite features that are not taught or suggested by the prior art. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143, *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Claim 1 of the present invention recites the use of audio file instructions for setting up a computer system. In contrast, the Dobbins patent involves the use of audio instructions only for medication containers and not for setting up a computer system. It is instructive to note that the Field of the Invention from the Dobbins patent states that the Dobbins device “relates generally to medication containers, and deals more particularly

with closures for these containers.” Furthermore, claim 1 of the Dobbins patent defines the scope of Dobbins’ invention as being drawn to “recording verbal patient instructions for the proper use of the medication.” Thus, Dobbins’ claim 1 indicates that the Dobbins patent is specific to medication containers and instructions for taking medication found within these containers. Consequently, the Dobbins patent does not teach a “memory containing audio file instruction for setting up a computer system” or “wherein the setup apparatus is activated upon a triggering event before the computer system is set up,” as recited in claim 1. The Dobbins patent also does not teach “method of assisting a user in set up of a computer system,” as recited in claim 16.

Claim 23, of the present invention, recites providing a user a set of audio instructions for setting up a computer system. Nowhere in the Dobbins patent is it disclosed, taught, or suggested that the invention of the Dobbins patent may be used in conjunction with a computer system or set up of a computer system. Indeed, the Dobbins device is limited to instructions for taking medication provided in medication containers.

From the discussion above, it is clear that the Dobbins patent does not disclose, teach, or suggest, the recited features of claims 1 and 16 of the instant application. As such, Dobbins fails to carry the burden of making obvious the recited features of claim 4, which depends from claim 1, and claims 22 and 31, which depend from claim 16. As stated previously, Dobbins fails to disclose, teach, or suggest, the recited features of claim 23, from which claim 28 depends. Here again Dobbins fails to carry the burden of a showing of obviousness.

Additionally, the Dobbins device teaches “a digital display 54 supported by with [sic] the upper surface.” Dobbins, col. 4, lines 10-11. However, Dobbins is silent as to how information is configured to be displayed and what information the display is configured to provide. Therefore, the Dobbins patent does not disclose or suggest “a display which displays an instruction number and instruction label for the audio instruction being present,” as recited in claim 4; or “displaying a legend indicating the instruction number and label corresponding to printed instructions,” as recited in claim 22 and also in claim 28. Therefore, the Dobbins patent fails to carry the burden of a showing of obviousness.

Accordingly, Applicant respectfully submits that the Dobbins patent does not

disclose or suggest the features of the claimed invention, as required for a showing of obviousness under §103. Therefore, withdrawal of the §103 rejection of claims 1, 4, 16, 22, 23, 28, and 31 is respectfully requested.

As the Office is well aware, Applicants are required to seasonably challenge statements by the Office that are not supported on the record. M.P.E.P. §2144.03. Further, it is noted that "Official Notice" is to be limited to instances where the facts are "capable of instant and unquestionable demonstration as being well-known". M.P.E.P. §2144.03. This is not the present situation. First, in accordance with M.P.E.P. §904 it is presumed that a full search was conducted and this search is indicative of the prior art. The search failed to disclose a reference which would teach or suggest modifying the Dobbins reference to achieve the present invention wherein an audio assisted computer set up apparatus is provided. Consequently, the search revealed that the asserted substitution is not well-known and therefore is not entitled to be relied upon in order to reject the present claimed invention. If the Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *M.P.E.P. 2141.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). As discussed above, the Dobbins device specifically pertains to medication containers and having these medication containers include instructions for taking the medication within. With such a limited Field of Invention, as identified above, and clearly defined scope of the claim coverage it would not have been obvious to one of ordinary skill in the art to speculate as to the effectiveness of a device, such as that in Dobbins, which provides assistance in setting up a computer, as recited by the present invention. Thus, the Dobbins patent, by making no mention of the usefulness of the claimed invention in any other manner than the "recording of verbal patient instructions for the proper use of the medication" (Dobbins, Claim 1), teaches away from the claimed invention of the instant application.

Further, in a previous Office Action dated March 17, 2003 the Examiner contended that a processor is inherently included by the function of a recording in the Dobbins patent. As stated above in reference to the Crowell patent, Applicant respectfully disagrees with this contention. To establish inherency, MPEP §2112 requires that the allegedly inherent feature must necessarily be present, and not merely a possibility:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP §2112 citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' MPEP §2112 quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

In the present context, it is certainly foreseeable that the function of recording discussed in the Dobbins patent may not be configured with a processor in the manner recited in the claims. Such receiving and retaining can be accomplished without the use of a processor. For example, receiving and retaining can be achieved using magnetic analog technology.

Consequently, it is respectfully submitted that the processor feature is not inherent as described in the Dobbins documents.

### ***§103 Rejection of the Claims in View of Crowell***

The §103 rejection of claims 1, 3, 6-14, 16, 18-21, and 23-27 in view of Crowell is respectfully traversed. The Office Action contends that all features of claims 1, 3, 6-14, 16, 18-21, and 23-27 are disclosed in the Crowell patent. Applicant respectfully disagrees.

The five Independent Claims 1, 9, 10, 16, and 23 of the instant application recite

features that are not taught or suggested by the prior art. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143, *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Claim 1 of the present invention recites the use of a memory operatively connected to the processor, the memory containing audio file instructions for setting up a computer system. In contrast the Crowell patent does not teach or suggest a memory, a processor, or the audio files contained within the memory, as disclosed by the present invention. Indeed, the Crowell patent makes no mention of a processor and memory. Further, as discussed previously, Crowell does not inherently teach a processor and memory. The Crowell patent discusses receiving and retaining an audio message, which as stated previously, may be accomplished by means other than a processor and memory. The burden is on the cited reference to clearly show the obviousness of the claimed invention in supporting a §103 rejection and in the present case that burden has not been met with respect to claim 1 of the instant application. Accordingly, claims 3 and 6-8, by virtue of their dependency from claim 1 are not shown to be obvious by the Crowell patent.

Claim 9, of the present invention, recites a container capable of holding computer system components having audio setup instructions attached. The Crowell patent does not teach such an invention. In fact, nowhere in the Crowell patent is such an invention suggested. Therefore, the Crowell patent fails to carry the burden of a showing of obviousness with respect to claim 9.

The Crowell patent fails to disclose, teach, or suggest "an audio assisted setup apparatus affixed to a component of the computer" as recited in claim 10 of the instant application. Thus, the Crowell patent fails to carry the burden of a showing of obviousness with respect to claim 10. As a result the Crowell patent fails to carry the burden of a showing of obviousness with respect to claims 11-14 which depend from claim 10.

The Crowell patent also does not teach "a method of assisting a user in set up of a computer system," as recited in claim 16. As a result the Crowell patent fails to carry the burden of a showing of obviousness with respect to claims 18-21 which depend from claim 16.

Claim 23, of the present invention, recites providing a user a set of audio instructions for setting up a computer system. The Crowell patent reveals no references to a computer. There is no suggestion in Crowell that the invention be used in conjunction with a computer system or setup of a computer system. Hence, Crowell does meet its burden for a showing of obviousness because it fails to teach or suggest "providing a user a set of audio instructions for setting up a computer system," as recited by claim 23. As a result the Crowell patent fails to carry the burden of a showing of obviousness with respect to claims 24-28 which depend from claim 23.

For the reasons stated above, Applicant respectfully requests withdrawal of the §103 rejection of claims 1, 3, 6-14, 16, 18-21, and 23-27 in view of Crowell.

As the Office is well aware, Applicants are required to seasonably challenge statements by the Office that are not supported on the record. M.P.E.P. §2144.03. Further, it is noted that "Official Notice" is to be limited to instances where the facts are "capable of instant and unquestionable demonstration as being well-known". M.P.E.P. §2144.03. This is not the present situation. First, in accordance with M.P.E.P. §904 it is presumed that a full search was conducted and this search is indicative of the prior art. The search failed to disclose a reference which would teach or suggest modifying the Crowell reference to achieve the present invention wherein an audio assisted computer set up apparatus is provided. Consequently, the search revealed that the asserted substitution is not well-known and therefore is not entitled to be relied upon in order to reject the present claimed invention. If the Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *M.P.E.P. 2141.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). As discussed above, the Crowell invention makes no specific mention of computers, computer systems, or providing any type of assistance in setting up computers and/or computer systems. With such an obvious



exclusion and clearly defined scope of the claim coverage it would not have been obvious to one of ordinary skill in the art to speculate as to the effectiveness of the invention in Crowell which provides assistance in setting up a computer, as recited by the present invention. Thus, the Crowell patent, by making no mention of the usefulness of the Crowell invention being used with computers or even identifying computers as a possible target of use for the invention in Crowell, Applicant respectfully submits that the Crowell patent teaches away from the claimed invention of the instant application. Therefore, withdrawal of the §103 rejection is respectfully requested.

***§103 Rejection of the Claims in View of Crowell/Galloway Combination***

The §103 rejection of claims 2, 29, and 30 in view of Crowell and further in view of Galloway is respectfully traversed. The Office Action contends that all features of claims 2, 29, and 30 are disclosed by the combination of the Crowell and Galloway patents. Applicant respectfully disagrees.

The Office Action acknowledges that Crowell does not teach or suggest a piezoelectric speaker. The Galloway patent is cited because it mentions using a piezoelectric transducer in a greeting card. However, the Galloway patent does not resolve the deficiencies of Crowell, as discussed above in regard to the §103 rejection of claim 1, from which claim 2 depends, claim 9, from which claim 29 depends, or claim 10, from which claim 30 depends. For example, like Crowell, Galloway does not disclose, teach, or suggest a method to a user a processor and memory in conjunction with audio instructions to aid a user in the setup of a computer system. Therefore, the hypothetical combination does not teach or suggest “a memory operatively connected to the processor, the memory containing audio file instructions for setting up a computer system” as recited in claim 2 by virtue of its dependency on claim 1. Additionally, the hypothetical combination does not teach or suggest “a container capable of holding computer system components having audio setup instructions attached” as recited in claim 29 by virtue of its dependency on claim 9. Further, the hypothetical combination does not teach or suggest “an audio assisted setup apparatus affixed to a component of the computer” as recited in claim 30 by virtue of its dependency on claim 10.

Therefore, Applicant respectfully requests withdrawal of the §103 rejection of

***§103 Rejection of the Claims in View of Crowell/Britton Combination***

The §103 rejection of claims 5, 15, and 17 in view of Crowell and further in view of Britton is respectfully traversed. The Office Action contends that all features of claims 5, 15, and 17 are disclosed by the combination of the Crowell and Britton patents. Applicant respectfully disagrees.

Similar to the Crowell/Galloway combination discussed above, the addition of the Britton patent does not overcome the deficiencies of the Crowell patent with respect to claims 5, 15, and 17. The Britton patent is relied upon for its discussion of using photo diodes in conjunction with medical equipment. However, the Britton patent does not teach or suggest using the use of audio files to provide instructions for setup of a computer system. Therefore, the deficiencies of the Crowell patent are not resolved by the addition of the secondarily cited Britton patent. Applicant respectfully requests withdrawal of the §103 rejection of claims 5, 15, and 17 in view of the Crowell/Britton combination.

***Response to Argument***

The Examiner, in the Response to Arguments section of the Office Action, states that Dobbins disclosure of a means for recording and storing instructions, a means for actuating the recorder and generating an audio signal, recording circuitry, and a display renders the present invention obvious. However, to follow this line of argument, the Examiner would have to assert the Dobbins patent as rendering obvious all patents which pertain to recording, storing, actuating, displaying, or audibly relaying any "instructions", which the Examiner defines in scope as "an alternative to paper instructions". Applicant respectfully submits that the Dobbins patent itself provides a clear indication as to the metes and bounds of its intended scope of coverage in its claim language. That claim language identifies clearly the intent of the Dobbins patent to cover instructions to taking medication provided with a medication container. Thus, Dobbins does not render the present invention obvious.

The Examiner further states that the Crowell patent's disclosure of receiving and retaining an audio message reads on a processor and memory, as recited in the present invention. Therefore, the Examiner maintains that the audio message could be recorded to provide instruction for anything, including a computer set up or information concerning a computer. Here again this line of reasoning would require the Examiner to assert the Crowell patent as rendering obvious all patents which pertain to receiving and retaining an audio message. Applicant respectfully submits that the Crowell patent provides a clear indication as to the metes and bounds of its intended scope of coverage by what it does not state. The Crowell patent makes no mention of computers, as recited in the present invention, or of using the Crowell invention in conjunction with a computer system or setup of a computer system, as further recited in the present invention. Thus, the Crowell patent does not render obvious the present invention.

Appl. No. 09/409,500

Reply to: Office Action of November 19, 2003

Title: AUDIO ASSISTED SETUP APPARATUS AND METHOD

**CONCLUSION**

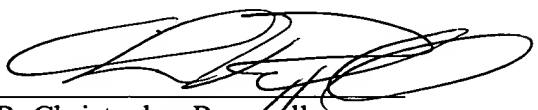
In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited. Accordingly, notification to that effect is earnestly requested. In the event that issues arise in the application which may readily be resolved via telephone, the Examiner is kindly invited to telephone the prosecuting attorney, identified below, at (402) 496-0300 to facilitate prosecution of the application.

Respectfully submitted,

Gateway Inc.,

Dated: February 19, 2004

By: \_\_\_\_\_

  
R. Christopher Rueppell  
Reg. No. 47,045

R. Christopher Rueppell  
SUITER • WEST PC LLO  
14301 FNB Parkway, Suite 220  
Omaha, NE 68154  
(402) 496-0300      telephone  
(402) 496-0333      facsimile